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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/961,181	09/24/2001	Takuro Ikeda	1405.1050	7175
21171	7590	07/22/2005	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			SMITH, TRACI L	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 07/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/961,181

Applicant(s)

IKEDA ET AL.

Examiner

Traci L. Smith

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is in response to papers filed on May 26, 2005.
2. Claims 1-11 were elected.
3. Claims 1-11 are rejected.
4. Claims 1-11 are pending.

Election/Restrictions

5. Applicant's election with traverse of claim 1-11 in the reply filed on May 26, 2005 is acknowledged. The traversal is on the ground(s) that no references were cited to show a necessity requiring restriction and references would contain both types of claims in the same field of technology. Examiner notes the arguments are directed to a requirement for restriction however application was given to an election of species, therefore arguments are improper. See MPEP 808.01a and 809.02a. This is not found persuasive because an election of species was made not a restriction. Applicant merely argues same technological art not that the species are not patentably distinct. The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

9. As to Claim 1-11 include language such as "assigning correspondences between" but then fail to identify what the correspondences are assigned to or between. As to "outputting dialogue content" where is the content being output to? Further more examiner is unable identify the different between transmitting the dialogue content and outputting the dialogue content.

10. Examiner is unclear as what applicant means by send-destination address.

11. As to claim 3 examiner is unclear as to what applicant means when "annexing to the dialogue content"

12. As to claims 7 and 8 it is unclear as to what exactly the criteria is for billing and compensation as well as how the criteria is used to determine both respectively.

13. Regarding claims 2-3, 5, 8 and 10; the word "means" is preceded by the word(s) "scenario storage means"; "customer information storage means" "processing means" "compensation criteria storage means" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the

equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).

Claim Rejections - 35 USC § 101

14. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

15. Claims 1-11 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

16. Mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process.

17. In the present case, claims 1-11 fail to recite the use of a computer system involved as the apparatus doing the steps recited. Presently the claims can be read as a paper process with a person taking information over the phone and making notes regarding the dialogue.

Claim Rejections - 35 USC § 102

18. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

19. Claims 1-6 and 9-11 rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 6,766,319 Might; Method and Apparatus for Gathering and Evaluating Information. Hereinafter, referred to as Might. The reference cited in this rejection is applied to the above mentioned claims as they are best understood by the examiner.

20. As to claims 1-2, 5-6 and 9-11 Might teaches

- a. Inputs with respect to specific categories that were previously stored(C. 2 I. 59-63).
- b. Picking which topic the individual wishes to participate in.(C. 3 I. 23-26).
- c. Communication between survey supplier and individual(C. 1 I. 20-23).
- d. Storing information from communication(C. 2 item 8).
- e. Reporting communication information(C. 3 I. 16-21).

21. Although, does not explicitly recited the information being “merchandise information” as recited in claims 5-6 it is inherent a if an individual is a customer they will be reporting on the “merchandise” was purchased or used from the provider.

Furthermore, the fact that the information is "merchandise information" these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The steps would be performed regardless of the type of information input. The claims fail to recite a manipulation of the information that is collected there, they are merely input and the transmitted in the same form in which they were input. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see in re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 44(Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ 2d 1031(Fed. Cir. 1994).

22. As to claim 3 Might teaches storing customer information that identifies the customer via information input by the customer(C. 3 I. 66-67 & C. 4 I. 1-3)

23. Might further teaches using statistical information rather than raw information therefore removing the users identity from the survey input information.

24. As to claims 4 Might teaches storing the communication information(C. 1 I. 20-23).

Claim Rejections - 35 USC § 103

25. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

26. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

27. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,766,319 Might as applied to claim 1-6 and 9-11 above, and further in view of US Patent Publication 2001/0032115 A1 Goldstein; System and Methods for internet commerce and communication based on customer interaction and preferences.

Hereinafter referred to as Goldstein. The references cited in this rejection are applied to the above mentioned claims as they are best understood by the examiner.

28. As to claim 7 Might teaches a system and method for users inputting information regarding products/services or merchandisers. Might fails to teach a means for billing/compensation and notification of billing/compensation information. Goldstein teaches purchasing information for survey information that a user requests from a survey they did not develop. Goldstein further teaches a portion of the proceeds going to the creator the survey as a means for compensating the creator for their work. It would have been obvious to one skilled in the art at the time of invention to combine the teaches of Goldstein with Might so as to have incentives to both using others surveys and creating surveys that other will be able to use the data from.

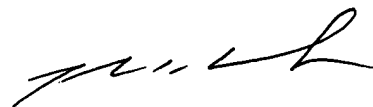
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Traci L. Smith whose telephone number is 572-272-6809. The examiner can normally be reached on Monday-Thursday 6:00 am-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tls



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